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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,943	11/13/2003	Chi-Jung Chang	0941-0866P	6577
2292	7590	12/06/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			MCCLENDON, SANZA L	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/705,943

Applicant(s)

CHANG ET AL.

Examiner

Sanza L. McClendon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Response to Amendment***

1. In response to the Amendment received on June 24, 2005, the examiner has carefully considered the amendments.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102/35 USC § 103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference

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is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over by Noguchi (6,428,862).

Noguchi teaches inkjet ink compositions comprising a coloring agent, a polymerizable oligomer, water and a photopolymerization initiator. Examples of said ink compositions can be found in columns 3-4. At least one of said examples includes a pigment and a water-soluble cationic or anionic polymeric compound for dispersing said pigment, an oligomer having at least two acryloyl groups, water, and a polymerization initiator. In column 6, Noguchi teaches using carbon black pigment with a water-soluble cationic polymeric compound dispersant--see column 6, lines 17-35. Said dispersant taught appear to have reactive groups. Water-soluble anionic polymeric dispersant are taught in column 7, lines 21-31, wherein these appear to be reactive, have carbon-carbon double bonds as end groups. Therefore, claims 2-4 are anticipated. Therefore it is deemed these anticipate applicant's reactive dispersants. Pigments can be found in column 8, lines 17-39. Said polymerizable oligomers having at least two acryloyl groups can be found in column 12, line 25 to column 21, line 32. These are added in amounts from at least 1 to 30 parts by weight, preferably from 5 to 20 parts by weight. These weight amounts are encompassed in applicant's weight ranges. Said photopolymerization initiators can be found in columns 21 to 25, wherein it is disclosed to be added, to the composition, in amounts from 0.3 to 10 parts by weight, preferably from 1 to 5 parts by weight. These anticipate applicant's photoinitiator limitation of claim 12. Claim 10 is anticipated by the teachings of Noguchi. Claims 11 and 13 are deemed anticipated since the examiner is interpreting them to be future intended uses of a reactive surfactant. Noguchi teaches using the same reactive surfactants, as defined by applicant, and therefore they should inherently be capable of the same

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functions as claimed by applicant, in the absence of evidence to the contrary. Claims 5-6 are deemed anticipated since Noguchi teaches at least some of those taught by applicant--see column 7, lines 25-30 and applicant's examples. Regarding claims 8-9, Noguchi is deemed to anticipate the instantly claimed invention, therefore the ink of Noguchi should inherently have the same surface tension. Per examples Noguchi appears to anticipate applicant's claimed weight amounts--see Tables 3-6. However, the Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether Applicant's composition differs and, if so, to what extent, from the discussed reference. Therefore, with the showing of the reference, the burden of establishing non-obviousness by objective evidence is shifted to the Applicants.

7. Claims 1-13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Noguchi (6,428,862).

Noguchi teaches inkjet ink compositions comprising a coloring agent, a polymerizable oligomer, water and a photopolymerization initiator. Examples of said ink compositions can be found in columns 3-4. At least one of said examples includes a pigment and a water-soluble cationic or anionic polymeric compound for dispersing said pigment, an oligomer having at least two acryloyl groups, water, and a polymerization initiator. In column 6, Noguchi teaches using carbon black pigment with a water-soluble cationic polymeric compound dispersant--see column 6, lines 17-35. Said dispersant taught appear to have reactive groups. Water-soluble anionic polymeric dispersant are taught in column 7, lines 21-31, wherein these appear to be reactive, have carbon-carbon double bonds as end groups. Therefore, claims 2-4 are anticipated. Therefore it is deemed these anticipate applicant's reactive dispersants. Pigments can be found in column 8, lines 17-39. Said polymerizable oligomers having at least two acryloyl groups can be found in column 12, line 25 to column 21, line 32. These are added in amounts from at least 1 to 30 parts by weight, preferably from 5 to 20 parts by weight. These weight amounts are encompassed in applicant's weight ranges. Said

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photopolymerization initiators can be found in columns 21 to 25, wherein it is disclosed to be added, to the composition, in amounts from 0.3 to 10 parts by weight, preferably from 1 to 5 parts by weight. These anticipate applicant's photoinitiator limitation of claim 12. Claim 10 is anticipated by the teachings of Noguchi. Claims 11 and 13 are deemed anticipated since the examiner is interpreting them to be future intended uses of a reactive surfactant. Noguchi teaches using the same reactive surfactants, as defined by applicant, and therefore they should inherently be capable of the same functions as claimed by applicant, in the absence of evidence to the contrary. Claims 5-6 are deemed anticipated since Noguchi teaches at least some of those taught by applicant--see column 7, lines 25-30 and applicant's examples. Regarding claims 8-9, Noguchi is deemed to anticipate the instantly claimed invention, therefore the ink of Noguchi should inherently have the same surface tension. Per examples Noguchi appears to anticipate applicant's claimed weight amounts--see Tables 3-6. However, the Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether Applicant's composition differs and, if so, to what extent, from the discussed reference. Therefore, with the showing of the reference, the burden of establishing non-obviousness by objective evidence is shifted to the Applicants.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The term "type" in claims 1-13 is a relative term which renders the claim indefinite. The term "type" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear exactly what a pigment-type ink composition. Does these mean that only pigment vs. dyes can be used. Is this intended to include clear ink compositions? Is this intended to described "effect" ink compositions, such as pearlescent, shimmer, gloss, and the like? Clarification is requested.


#### **Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sanza L. McClendon  
Examiner  
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SMc